

REMARKS

Claims 1-6, 8-64 and 73-75 are pending in the application. Claims 65-72 stand withdrawn from consideration. Claims 1-6, 8-64 and 73-75 were rejected. Claims 3-6, 9-12, 27, 35-39, 41-43 and 54 were objected to as being dependent upon a rejected base claim and were otherwise found to be allowable by the Examiner. Claims 1, 14, 33, 39 and 61 have been amended. No new matter has been added.

Reconsideration is respectfully requested in view of the following remarks.

Response to Rejections Under 35 U.S.C. §112

Claims 1-6, 8-64 and 73-75 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. In particular, the Examiner alleged that claims 1, 14, 33 and 39 were indefinite because of Applicants' use of the term "adapted." As suggested by the Examiner, claims 1, 14, 33 and 39 have been amended to delete the term "adapted."

Claims 61-64 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being "unclear whether or not claims 61-64 incorporate all the limitations of claims 1 (or alternatively claim 33)." Claim 61 has been amended to more clearly recite that claim 61 incorporates all the limitations of the urethral suppository of either claim 1 or claim 33.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §112 be withdrawn.

Response to Rejections Under 35 U.S.C. §102

Claims 1, 2, 8, 15, 18-21, 23, 32-34, 40, 45-48, 50, 58 and 61-64 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,460,360 to Finegold (hereinafter "Finegold"). Claim 1 includes a feature neither disclosed nor suggested by Finegold, namely,

a meltable portion formed around at least a portion of said length of said reinforcement, said meltable portion having a diameter which tapers toward said first end, said meltable portion adapted for insertion into said urethra. [emphasis added].

Although Finegold may describe a urethral suppository, it does not describe a suppository having a meltable portion formed around a reinforcement; nor does it describe a suppository having a taper from a second end toward a first end.

The Examiner refers to the obstructor 66 in Figure 4 of Finegold as a non-meltable reinforcement. The Examiner refers to the suppository 62 as a meltable portion. Finegold neither discloses nor suggests a meltable portion disposed around a non-meltable portion. Specifically, Finegold describes that the suppository 62 is attached to one of the flat surfaces, as shown in Fig. 4, surface 68 of the obstructor 66 (see column 4, lines 4-5). Being attached to a flat surface is different from the claimed feature of the meltable portion being formed around a reinforcement.

In accordance with the dictionary definition of the word “around,” the term as used in claim 1 means that the meltable portion surrounds at least a portion of the reinforcement. (See enclosed pages of definition of word “around” from Random House College Dictionary). There is no portion of the obstructor 66 that is surrounded by the suppository 62.

In addition, the suppository 62 of Finegold is not tapered according to the feature of claim 1. The Examiner suggests that the distal end 65 of the suppository 62 of Finegold is tapered. The specification describes the tip 65 of the suppository as being “rounded.” (see column 3, lines 62-65). This is different from the claimed feature of a meltable portion that tapers because the rounded tip of Finegold tapers in a direction opposite the claimed taper of the meltable portion.

The rounded tip of Finegold tapers in a direction toward the end of the tip 65 and away from the base member 72. In contrast, the meltable portion of claim 1 tapers toward the first end (e.g., tapers in a direction toward the base member).

Accordingly, claim 1 is not anticipated by Finegold, since Finegold neither discloses nor suggests a meltable portion around at least a portion of a reinforcement and neither discloses nor suggests a meltable portion tapered toward a first end of a reinforcement. In addition, claim 1 is not obvious in view of Finegold because Finegold teaches away from the features of the claimed suppository.

Finegold teaches away from a suppository having a meltable portion formed around the obstructor 66 which was alleged by the Examiner to be a non-meltable reinforcement.

The obstructor 66 is sized to prevent its insertion into the urethra (see column 4, lines 25-47 and Fig. 5). The purpose of the instrument of Finegold is to anesthetize the urethra (see abstract). If a meltable portion is formed around the obstructor 66, the meltable portion would not serve the function of medicating the urethra because the meltable portion on the obstructor would be too large to enter the urethra . In addition, the tapers of the claimed and prior art devices are in opposite directions because the devices serve different functions. The rounded tip 65 of Finegold presumably facilitates insertion of the suppository 62 into the urethra. The tapered meltable portion of claim 1 helps retain the claimed suppository *within* the urethra.

Accordingly, claim 1 is not anticipated by and not obvious in view of Finegold at least because Finegold neither discloses nor suggests a meltable portion around at least a portion of a reinforcement and neither discloses nor suggests a meltable portion tapered toward a first end of a reinforcement.

Claim 33 similarly includes the same features of claim 1 directed to a meltable portion formed around a reinforcement and a taper toward a first end of a reinforcement. Accordingly, claim 33 is novel over Finegold at least for the same reasons explained above with regard to claim 1.

Claims 2, 8, 15, 18-21, 23, and 32 depend from claim 1, claims 34, 40, 45-48, 50 and 58 depend from claim 33, and claims 61-64 all include the features of a meltable portion formed around the reinforcement and a taper toward the first end of the reinforcement as described above with regard to claim 1. Accordingly, claims 2, 8, 15, 18-21, 23, 32, 34, 40, 45-48, 50, 58 and 61-64 are not anticipated by Finegold at least for the same reasons as discussed above with regard to the patentability of claim 1.

Response to Rejections Under 35 U.S.C. §103

Claims 16, 17, 24, 25, 30, 31, 51, 52, 57, 59, 60 and 73-75 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Finegold. Claims 13 and 14 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Finegold in view of U.S. Patent No. 6,645,201 to Utley et al. (hereinafter "Utley"). Claims 22 and 49 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Finegold in view of

U.S. Patent No. 4,542,020 to Jackson et al. "Jackson"). Claims 26, 28, 29, 53, 55 and 56 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Finegold in view of U.S. Patent No. 1,767,785 to De Shushko (hereinafter "De Shushko").

Claims 13, 14, 16, 17, 22, 24-26, 28-31, 49, 51-53, 55-57, 59, 60 and 73-75 depend from either claim 1 or claim 33 and therefore include all the features of claim 1 or claim 33. Accordingly, these claims are patentable over the cited references at least for the same reasons as discussed above with regard to the patentability of claims 1 and 33.

Allowable Subject Matter

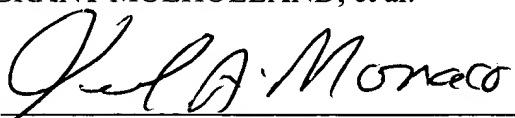
Claims 3-6, 9-12, 27, 35-39, 41-43 and 54 were objected to as being dependent upon a rejected base claim and was otherwise found to be allowable by the Examiner. These claims depend from either claim 1 or claim 33 and therefore include all the features of claim 1 or claim 33. Accordingly, these claims are patentable over the cited references at least for the same reasons as discussed above with regard to the patentability of claims 1 and 33.

The claims of the application are believed to be in condition for allowance. An early action toward that end is earnestly solicited.

Respectfully submitted,

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The Random House College Dictionary

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**Based on The
Random House
Dictionary of the
English Language**

THE UNABRIDGED EDITION

JESS STEIN • EDITOR IN CHIEF

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